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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,086	11/26/2001	Gerhard Schnabel	514413-3884	6212

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EXAMINER

CLARDY, S

ART UNIT PAPER NUMBER

1616

DATE MAILED: 06/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/890,086	Applicant(s) Schnabel et al
Examiner S. Mark Clardy	Art Unit 1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Apr 14, 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) 18 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3, 14, and 15 is/are rejected.
- 7) Claim(s) 4-13, 16, and 17 is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).*See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7
- 4) Interview Summary (PTO-413) Paper No(s). _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other:

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Claims 1-18 are pending in this application which has been filed under 35 USC 371 as a national stage application of PCT/EP00/00469, filed January 22, 2000. This application lacks unity of invention under 37 CFR 1.475 (MPEP 1850, 1893.03(d)).

In response to the requirement for restriction and election of species, applicants have elected the invention of Group I, claims 1-17, drawn to sulfonylurea compounds (see formula Ia, claim 3) and methods of making them (claims 14, 15, 17), compositions comprising them (claims 1-12), and their use as herbicides or plant growth regulators (claims 13, 16).

Claim 18, drawn to the (non-statutory) use of phosphonium or sulfonium salts of polyalkoxylated hydrocarbyl compounds of formula XVIII, has been held withdrawn from consideration as being drawn to an invention non-elected with traverse in Paper No. 9.

Applicants further elected, with traverse, the species within Group I comprising the sulfonylurea species of iodosulfuron-methyl SMe₃ (page 28, Table 4, compound 1).

Again, upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Comparative data has been presented in Table 1 at the end of the specification (note that there is another Table 1 on page 25), but it cannot be determined whether the elected compound is any of the tested herbicides (identified as compounds 4.2, 3.6, or 4.14; presumably referring to Tables 3 and 4, pages 26 and 28).

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Claims 4-13, 16, and 17 are objected to under 37 CFR 1.75© as being in improper form because a multiple dependent claim may not depend from another multiply dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Note that claims 13, 16, and 18, which have been either withdrawn from consideration, or objected to, will be subject to a rejection under 35 USC 101 as being drawn to a non-statutory class of invention (“use”), should they be taken up for consideration on the merits.

Examination has proceeded for claims 1-3, 14, and 15.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker et al (PCT WO 96/41537) in view of Gesing et al (US 6,451,737) and Mayer et al (US 6,413,911).

Hacker et al teach that iodosulfuron-methyl was a known herbicidal agent (abstract, R¹=C₁ alkyl; page 5, lines 22-33), and that agriculturally acceptable salts (e.g., Na, K, ammonium) were known to be herbicidally useful as well (page 6, lines 1-7). Trimethyl (or trialkyl) sulfonium salts are not disclosed.

Gesing et al and Mayer et al teach that, in addition to sodium, potassium, ammonium, and other conventional salts, the trimethylsulfonium salts of sulfonylurea herbicides were known in the

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art (Gesing et al, claim 1; Mayer et al, col 8, lines 16-41). The sulfonylurea compounds of Gesing differ from iodosulfuron in the substituents on the phenyl ring, while the sulfonylurea herbicides of Mayer et al differ in the 4,6-substituents on the triazine ring, and have non-fluorine halogen substituents on the phenyl ring. Mayer et al also teaches the methods of making salts of sulfonylurea herbicides.

One of ordinary skill in the art would be motivated to combine these references because they teach that salts of sulfonylurea herbicides retain herbicidal utility.

Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have made the trimethylsulfonium salt of iodosulfuron because this herbicide was known in the art and because the trimethylsulfonium salts, like the more common examples of sodium, potassium, and ammonium salts, were known in the art.

It cannot be determined from the data presented in the specification whether the elected species has been tested in order to demonstrate unexpected results.

No unobvious or unexpected results are noted; no claim is allowed.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.



**S. Mark Clardy
Primary Examiner
AU 1616**

June 23, 2003